

IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1917.

NEW YORK SCAFFOLDING COMPANY,

vs.

Plaintiff,

LIEBEL-BINNEY CONSTRUCTION COMPANY,

Defendant.

On Petition for Writ of Certiorari.

BRIEF FOR RESPONDENT.

This is a suit against a user of a set of Whitney scaffold hoists. The only set that ever passed into the possession of this user is shown to have been purchased by it in May, 1914. It does not appear that any such hoist has been made or sold since that date. The court found the patent invalid for want of invention and dismissed the bill. The pretext for asking this writ is the inaccurate assertion that the Court of Appeals of the Seventh Circuit and that of the Eighth Circuit have held that this "Whitney Scaffold Hoist" is an infringement of the patent in suit. The fact is, as will appear from examining the decisions of those courts, that they have both held (on a different record) that there is no novelty in what is recited in the claims of the patent here in suit; that the hoists are not patentably

distinguished from prior hoists; that it is only by reading into those claims a limitation to the omission of any fastenings between the hoist and the timbers laid upon it, and the placement of the hoist parallel to the wall instead of edgewise to it (one of the alternative uses described in the patent as equivalents, between which no distinction is made in the claims), that the Henderson platform hoist, or the scaffold laid on it, can be distinguished from the prior art; and that it is only by using this hoist placed *parallel to the wall without fastening the timbers to it* that any defendant could incur the charge of even *contributory* infringement. It is also distinctly held by the same courts that the hoists manufactured by Whitney (the manufacturer of defendant's hoists), since about the time of this sale in May, 1914, did not infringe the patent in suit under any interpretation, or however placed.

This Whitney Scaffold Hoist is equally capable of being used flatwise or edgewise to the wall, and the almost universal method of using such hoists, both before and since this particular sale, has been with them placed edgewise to the wall and fastened to the cross timbers. The present record shows that this is plaintiff's universal practice, and that what it is manufacturing is not the hoist of the patent in suit, but the hoist of the prior Murray patent, No. 854,959, which the present record shows has been the exclusive form of platform hoist manufactured by it and its licensees from a time long antedating Henderson's alleged conception, down to the present time—the hoist which plaintiff marks under the prior Murray patent, not under the Henderson patent, and which it puts out so connected as to be set only *edgewise* to the wall and with the timbers positively *fastened* to the hoists; that is, in precise conformity with the prior Murray patent.

There is no proof in the present case that the defendant ever used the Whitney Scaffold Hoist in a manner that

would have brought it within the only interpretation of the patent that has ever been sustained, or, in fact, that it had been used by the defendant in any way before this suit was brought. The court was, therefore, compelled to choose between finding the patent invalid or finding it not infringed. It took the more logical course, and that which the record before it obliged it to take if it were to give heed to the decisions of this court on the subject of patentable invention, in finding that the patent was altogether invalid, instead of reading into it fanciful limitations which would, as shown by the record before it, have imparted no patentability, and which would, as matter of fact, have excluded infringement under the interpretation resorted to by other courts in order to sustain the patent.

The plaintiff here stood upon the broad proposition that the claims were to be taken as covering the hoist, however placed. The record showed that the Court of Appeals of the Eighth Circuit had been in error in supposing that the common practice was to use such hoists set parallel to the wall without positive attachments between them and the timbers, and in assuming that it was the hoist of the Whitney patent so placed that the plaintiff had been manufacturing and selling; that it had attributed to this purely arbitrary placement and supposed omission of fastening devices (the fastening devices actually used not having been shown by the exhibit), a merit which did not exist, and credited to it the extensive sale of the plaintiff's machine which, as matter of fact, was made under and in accordance with the prior Murray patent and did not contain either of the features that the court supposed to be the key to success.

It appears, by cross-examination of plaintiff's witnesses in the present record, that the premise upon which the patent was originally sustained thus limited, was a delusion; that plaintiff's entire business in platform hoists, as well

before as since the alleged Henderson invention and its acquisition of the Henderson patent, has been under and in accordance with the prior Murray patent, and has excluded both of these features because they were and are considered undesirable; that it has not made a hoist to be used in accordance with the Henderson patent as thus interpreted, either before or since it purchased that patent in May, 1911 (R., p. 174), and that its machines are not, and cannot be, dismantled and taken into the window in the manner which the Court of Appeals of the Eighth Circuit, in its first opinion, thought constituted Henderson's invention.

The platform hoist of the expired Bowyer & Casperson patent, No. 382,252 (Rec., p. 186), corresponds more closely to the Henderson than does the Whitney Scaffold Hoist, and has precisely the same operation, carrying the timbers loosely on the bottom of its U-frame, while the Murray, No. 854,959 (R., p. 206, *et seq.*), shows the arrangement of similar hoists in sets of fours, operating in the same way as the Henderson, but set edgewise and pivotally attached to the cross timbers. This is not to be confused with the Murray, No. 882,206, which precedes it in the record.

If the Court of Appeals of the Eighth Circuit had, upon the original hearing, known what is disclosed from the cross-examination of plaintiff's witnesses in the present case, it would probably have been unanimous in affirming the decision below, holding the patent altogether invalid, instead of dividing, as it did, on that question. Its misapprehension in assuming that the parallel placement and the absence of fastenings was an advantage, and was generally adhered to in the use of these hoists, is completely exposed by the present record, where plaintiff's witness Cavanagh, in cross-examination, admitted that plaintiff's manufacture was the Murray machine set edgewise and positively attached to the timbers, and had been

throughout; that 70 per cent. of the trade were using Murray machines so set and attached, and that the other 30 per cent. were using the still older Cavanagh hoist (R., pp. 100-107). Plaintiff's advertising matter is introduced here, showing that the Murray was exclusively advertised as its manufacture, set edgewise and bolted to the cross-timbers; that it had been thus made and put into use in large quantities long before Henderson's earliest claimed date of conception; that it was used in the construction of the great buildings of the country by plaintiff and its licensees and under their authority. See Plaintiff's Exhibits 11, 12 and 13, offered p. 101; also Defendant's Exhibit C, R., p. 182, particularly the drawing at p. 13 of this catalogue, and the reprint on p. 15, from a publication of November, 1910, stating that over 8,000 of these hoists had then been successfully employed. This publication was, as shown on p. 3, in November, 1910, long prior to the acquisition of the Henderson patent, and referred to uses long prior to Henderson's alleged invention, including those on the buildings recited, p. 25, as among those on which this Murray hoist had then been used.

Davidson had, in his direct examination, described this Murray platform hoist as being upon the market prior to the Henderson (R., p. 71).

In the Eighth Circuit case, when it first went to the Court of Appeals, there was evidence to show that Whitney had used his original hoist placed edgewise to the wall, and it was assumed that he had used it without attachment of the timbers, because the attachment was not shown. The court seems to have supposed that there was some economy in space obtained by this placement and some advantage in having the timbers removed without releasing fastenings. It should have been too evident to require proof that no prudent contractor would use such hoists without some positive attachment for the timbers, since, by so doing, he would im-

peril the lives of operators, who have to work at a height of many stories; and that when placed *edgewise* to the wall there was less obstruction of the wall to be built or treated than when placed parallel. Any raising of one of these hoists, if not positively attached to the timbers, would imperil the slipping of the timbers off their supports and plunging the men and whatever else was on the platform to the street below. The placement of the hoist edgewise facilitated the positive attachment, and was, in fact, more economical of space than the placement parallel with the wall, where, as in the Henderson patent, a windlass hoist was used. Henderson had illustrated both positions as alternatives, but had laid no claim to any invention in any respect except the forming of the U-bar in a *continuous bent piece of metal*, having both the bearings of the windlass and the support for the platform in the same piece of metal. He claimed to have obtained some economy in this. The Whitney hoist never employed this construction, to which the claims were in terms limited, while the prior Bowyer *et al.*, hoist had the continuous U-frame, carrying the bearings of the windlass on brackets attached to its upright arms, the timbers resting freely on the bottom of the U.

The Whitney scaffold hoist, as sold to the Liebel-Binney Construction Co., did not have the bearings in the U-frame, but, like the old Bowyer *et al.*, had them in a bracket mounted on the U-frame, a distinction which was relied upon to escape the Bowyer *et al.*, and plainly excluding the Whitney scaffold hoist, which also lacked the *continuous* U-frame made in a single piece, so emphasized in the specification and claims of the Henderson patent, and which was present in the prior Bowyer *et al.*

There is not a particle of evidence to show that the Liebel-Binney Co. ever used the Whitney hoist in any manner that would constitute contributory infringement under the interpretation given the patent in either the Seventh or the

Eighth Circuits, and there is no presumption that they would have so used it, or intended it to be so used, because the practically universal use of such hoists, both then and since, has been in the manner of the Murray. Plaintiff called a witness to testify that he had seen these hoists (apparently at some time after the suit was brought) used set parallel to the wall. He was an employe of plaintiff, only saw them at a distance, did not know whether they were attached or unattached, or whether Liebel-Binney Co. had anything to do with that use. For aught that appears, it may have been a use procured by the plaintiff. The purchase of a set of such hoists just prior to the bringing of the suit carried no implication of intention to use them either parallel to the wall or unattached. The presumption would be that they were to be used in the way then and since almost universal, that is, edgewise and attached. Hence, if the Court of Appeals of the Third Circuit had disregarded the evidence before it, showing that the Court of Appeals of the Eighth Circuit had been under a misapprehension in supposing that there was any utility or advantage in the parallel placement and absence of attachment, it would still have been compelled to dismiss the bill for want of infringement. Plaintiff's contention here was necessarily that the patent was not limited to either of these features, for, in view of its own practice, exposed in this record, it could not decently contend that there was any practical advantage in either the parallel placement or the absence of fastenings. The contention that the original Murray was defective because of a rigid attachment between the cross-timbers and the frame of the hoist, and that the Henderson invention consisted in introducing a loose attachment, is preposterous. The Murray patent shows a pivotal attachment that would have afforded all the play desired, and the evidence shows that plaintiff's hoists are still universally made and used in accordance with the Murray patent, just as they were prior to the alleged Henderson

invention. The loose attachment was illustrated in the prior Bowyer *et al.*, and the advantage or disadvantage of allowing greater or less play between the frame of the hoist and the timber supported by it was a matter within the intelligence of the most ordinary mechanic. Henderson neither made nor claimed any invention in this respect, and neither of the decisions invoked by petitioner has given any such interpretation to his claims.

Practically the only question involved here is whether one or another reason should be assigned for a decree dismissing the bill, which must have failed in any event. The matter in controversy is utterly trivial, and the decision in the Third Circuit is plainly right. It has the concurrence of all four judges, as well as the concurrence of two of the judges sitting originally in the Eighth Circuit, who had not before them all the reasons for reaching this conclusion that are presented in this record.

It is further insisted by petitioner that there was error in not including Whitney as a party defendant in this case. Petitioner is insisting correctly that Whitney was a party to the case in the Eighth Circuit, where he was sued under the same patent for selling the so-called Whitney scaffold hoist, and that it now has a decree in that circuit, where it elected to sue him, determining as between him and plaintiff their respective rights. This being so, it certainly was not entitled to bring another suit against Whitney based upon the same identical infringement which was the subject of the Eighth Circuit suit. It is not pretended that he is a resident of any other district than that in which he was sued in the Eighth Circuit, or that he had in any wise violated the original decree of the Eighth Circuit. Hence, it would have been utterly absurd for the Court of Appeals of the Third Circuit to grant a decree against him covering the same subject-matter already adjudicated or in process of adjudication in the Eighth Circuit. Nor has petitioner any ground for complaint that the decree dismissing the bill for

want of equity did not include Whitney. The fact that Whitney was helping to defend his vendee did not deprive that vendee of any defense to which it was entitled. It had not been a party to the Eighth Circuit suit. If it had been, there would have been no occasion for bringing this suit. If Whitney is controlled by such decree as has been entered, or shall be entered, in the Eighth Circuit suit, no decree entered in the Third Circuit could at all change the *status*. It is the course which petitioner undertook to pursue, the absurdity of which the court of the Third Circuit immediately detected, which would lead to the confusion which the petitioner complains of. The refusal to include one who was defendant in the Eighth Circuit, in a subsequent suit for the same cause of action in another circuit, was the best possible way to avoid the confusion discussed in petitioner's brief. If conforming to the decision of this court in *Railroad Supply Co. v. Elyria Iron Co.*, 244 U. S., 285, the court of the Third Circuit must either have held the patent altogether invalid or held it so limited that there was no infringement by either of the hoists in controversy, and would have been justified in holding that it was neither valid nor infringed.

It is submitted that the court of the Third Circuit was right in dismissing this bill on the ground that it did; that if it had followed the interpretation of the patent adopted in either the Seventh or Eighth Circuits, it must still have dismissed the bill; that the matter in controversy here is so utterly trivial, and so plainly a question of fact in applying well settled rules of law, that there is no excuse for prolonging this litigation and making it further burdensome to defendant by issuing the writ here prayed for.

Respectfully submitted,

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